

**REMARKS**

This amendment is in response to the Office Action mailed April 17, 2003. Claims 1-38 were outstanding in the Office Action. Claims 1-38 were subjected to a Restriction requirement under 35 USC 121, in a letter mailed January 31, 2003. Claims 1-21, 28-30 and 33-38 were withdrawn by the Examiner as being directed to a non-elected invention. Applicants, in an amendment mailed February 28, 2003, elected the invention of Group II, drawn to a nail cutter, claims 22-27, 31 and 32. Claims 22-27, 31 and 32 were rejected in view of the prior art. Claims 22-27, 31 and 32 were rejected in view of the prior art. Applicants respectfully request that the above-identified application be reconsidered in view of the above amendments and remarks, which follow, and that each of the presently pending claims be allowed and the application be passed to issue.

By this amendment, claims 1-21, 28-30 and 33-38, drawn to the non-elected invention, have now been cancelled. Claims 22, 24, 26, 31 and 32 have been amended to overcome the Examiner's 35 USC 112 second paragraph rejection.

**35 USC 112 Rejections**

Claims 31 and 32 stand rejected under 35 USC 112 for indefiniteness. Claims 31 and 31 have been amended in order to overcome the rejection under 35 USC 112. Also, claims 22, 24 and 26 have similarly been amended.

**35 USC 103 Rejections**

Claims 22-25, 31 and 32 stand rejected by the Examiner under 35 USC 103 as being unpatentable over Werner, in view of Schretter.

Claim 22 recites that the nail cutter body includes a pentagonal pocket. This limitation is not disclosed or suggested by Werner or Schretter. The Examiner describes the Werner patent as disclosing a holding body having a pentagonal pocket formed by sides (21, 21a) that from an acute locating angle. The applicants respectfully submit that the Examiner is incorrectly identifying this limitation as being present in Werner. The cutter body as shown in figures 3 and 5 of Werner does not form a pentagonal pocket. As shown in figure 1, a pentagonal pocket is formed by the combination of the holder body and two bolt heads (28a, 28). The die holding mechanism in Werner includes the two clamping bolt heads (23, 23a) that form two sides of the pentagonal pocket. The bolt heads pull the die 35 in Werner rearward into its fixed position. Accordingly, to modify Werner so that these sides of

the pentagonal pocket, formed by the bolt heads (28, 28a), would have been integral with the holder body would destroy the intended purpose of the retractable bolt heads, to clamp and fix the insert die into position. As set forth in the Werner description, this is an objective of the die holder design, to provide a die holder having bolt head means that form two sides of a pentagonal pocket for firmly and rigidly clamping insert dies to the holder body, see column 2, lines 19-28. Further, the Examiner takes the position that it would have been obvious to provide the die insert of Werner with cutting surfaces as taught by Schretter. As was well known in the art at the time of Werner's invention, the purpose for having multisided insert dies (pentagonal, hexagonal) was so that the insert could be indexed five or six times to align the next unused semi-cylindrical groove into position to hold nail-making wires once the hard material of the insert had worn down on a semi-cylindrical holder groove. Whereas, the die insert in Schretter is purposefully designed as pentagonal or hexagonal for indexing purposes, but is rectangular with four sides and has tooling features on only one side thereof. The die inserts in Schretter are not indexed about all four sides as in Werner. Further, the insert in Schretter is deliberately split to reduce undesirable tensile stress and could not perform this intended function for other orientations of the die insert if it was indexed on each side. It is unclear what motivation an artisan would have in view of Schretter to form cutting surfaces on all five sides in Werner.

The Examiner has no teaching that suggests making a nail cutting holder insert indexable, let alone a pentagonal indexable holder insert, such as Werner. The Schretter patent discloses a nonanalogous holder that is employed for holding inserts that have only one working side, not a plurality of sides, as in Werner. There is no suggestion to combine Shcretter with Werner. It is respectfully submitted that the proposed combination of references by the Examiner under 35 USC 103 does not meet the limitations set forth in claim 22.

Claims 26 and 27 stand rejected under 35 USC 103 as being unpatentable over Werner in view of Schretter and Andersson. In the outstanding Office Action, the Examiner takes the position that it would have been obvious to round the angles of Werner, as taught by Andersson, in order to easily seat the insert corners. In the '771 patent to Andersson, the cutting edges are shaped so as to be rounded at 16, 16a, so that there are at least eight pairs of cutting edges, see column 3, lines 1-16. These eight pairs result in better economy in milling.

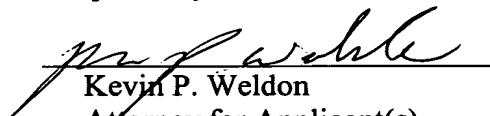
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Response to Office Action Mailed April 17, 2003

The active minor cutting edge 16A is oriented so as to generate the work surface, and cutting edge 16B is rounded rearward so as to be spaced a distance from the workpiece surface, see column 4, lines 34-58. Andersson does not disclose rounded corners "in order to easily seat the insert corners" as set forth by the Examiner, but the corners are rounded to form cutting edges to shape workpieces. The Examiner is requested to identify in the Schretter patent where this teaching is disclosed. The Examiner is using the present application as a guideline in constructing the claimed invention. It is respectfully submitted that such construction of the claims is considered to be impermissible hindsight and improper under 35 USC 103.

In view of the above amendments and comments, it is believed that claims 22-27, 31 and 32 are patentable over the art of record. Thus, applicants respectfully request a Notice of Allowance indicating claims as being allowable. If for any reason the Examiner does not believe that the application is in condition for allowance, the Examiner is requested to telephone applicant with any comments or questions (724-539-3848) in order to expedite prosecution of the application.

The Commissioner is hereby authorized to charge any fees, including additional filing fees required under 37 CFR 1.16 and 1.17, and fees for extension of time of three months, in connection with this submission to Kennametal Inc. AMSG corporate Deposit Account No. 502832.

Respectfully submitted,

  
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